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INTELLECTUAL PROPERTY TECHNOLOGY LAW FIRM

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Research Triangle Park, NC 27709

In re Application of

ROMAN *et al*

U.S. Application No.: 10/563,025

PCT No.: PCT/EP2004/007195

Int. Filing Date: 30 June 2004

Priority Date: 30 June 2003

Attorney Docket No.: 4258-119

For: IN VITRO METHODS FOR

DETECTING RENAL CANCER

**DECISION**

This is a decision on the papers filed 11 February 2008.

### **BACKGROUND**

On 13 November 2007, a decision dismissing applicants' petition under 37 CFR 1.497(d) was mailed. The filing receipt mailed 11 October 2007 and the Form PCT/DO/EO/903 mailed 12 October 2007 were vacated in the decision. Applicants were given two months to respond with extensions of time available.

On 11 February 2008, applicants filed a renewed petition under 37 CFR 1.497(d) which was accompanied by, *inter alia*, a one-month extension and fee, a petition under 37 CFR 1.183, and authorization to charge any required fee to Deposit Account No. 08-3284.

### **DISCUSSION**

The international publication (WO/2005/003776 published 13 January 2005) lists Maria Eladia Arguelles Sanchez as an Applicant/Inventor of PCT/EP2004/007195 which is the underlying international application of the subject application. Applicants claim that Ms. Arguelles Sanchez is not an inventor and should be removed.

To remove an inventor in these cases, applicants must meet the requirement of 37 CFR 1.497(d), which states:

(d) If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(l); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignees.

The prior decision mailed 13 November 2007 noted that applicants failed to complete items (1) and (3) of 37 CFR 1.497(d). To satisfy item (1) of 37 CFR 1.497(d), applicants must either locate and obtain the consent of Ms. Sanchez, file a petition under 37 CFR 1.183 to waive this requirement, or refile the application as a continuation of PCT/EP2004/007195 naming the correct inventive entity. Applicants must also provide written consent of the assignee to meet the requirements of item (3).

In the renewed petition, a written consent of the assignee signed by Laureano Simón, the CEO of the assignee was provided. The position of CEO in an organization is presumed to have the authority to sign for the organization. See § 324 MPEP. Applicants also provided the reel and frame number of the assignment which was verified as correct. This is sufficient to satisfy item (3) of 37 CFR 1.497(d).

With regard to item (1) of 37 CFR 1.497(d), applicants filed a petition under 37 CFR 1.183 to waive the requirement for a statement from Ms. Arguelles Sanchez. Under 37 CFR 1.183, any requirement of the regulations, which is not a requirement of the statutes, may be waived by the Commissioner's designee in an extraordinary situation, when justice so requires. A petition under 37 CFR 1.183 also requires a \$400.00 petition fee. This fee has been charged to Deposit Account No. 08-3284 as authorized.

Applicants request a suspension of the rules because Ms. Arguelles Sanchez is unavailable and cannot be located. Petitioners claim that "by the evidence of the record, diligent efforts have been made to locate Maria Eladia Arguelles Sanchez and prospects have been exhausted for locating her." However, there is **no evidence that a diligent effort has been made to locate Ms. Arguelles Sanchez in the record.**

In documents filed 03 August 2007, applicants assert that "diligent efforts have been initiated and are continuing to secure a statement from Maria Eladia Arguelles Sanchez." But applicants provided no corroborating evidence of these 'diligent efforts' and any results of this search. The letter submitted on 03 August 2007 from the Spanish law firm also did not discuss any effort made to contact Ms. Arguelles Sanchez.

Petitioners must provide satisfactory evidence that Ms. Arguelles Sanchez cannot be located after a diligent search before the petition to waive the statement requirement of 37 CFR 1.497(d) will be considered.

Applicants should provide a statement of facts outlining the steps taken to locate Ms. Arguelles Sanchez by a person with first-hand knowledge of these facts. Applicants should include copies of all relevant documentary evidence in support of this claim which would include internet/telephone searches, copies of cover letters, postal receipts, e-mails, and contact with former employers, etc. showing that a diligent effort was made to contact Ms. Arguelles Sanchez no avail.

In addition, it is noted that the requirement of item (1) of 37 CFR 1.497(d) is not one that ordinarily is waived because **relief is available by other means**. Specifically, applicants can file a continuation application under 37 CFR 1.53 without naming Ms. Arguelles Sanchez as a co-inventor.

Section 201.03 of the MPEP, in part:

Correction of inventorship may also be obtained by the filing of a continuing application under 37 CFR 1.53 without the need for filing a request under 37 CFR 1.48<sup>1</sup>, either in the application containing the inventorship error (to be abandoned) or in the continuing application. The continuing application must be filed with the correct inventorship named therein. The filing of a continuing application to correct the inventorship is appropriate if at least one of the correct inventors has been named in the prior application (35 U.S.C. 120 and 37 CFR 1.78(a)(1)). That is, at least one of the correct inventors must be named in the executed oath or declaration filed in the prior application, or where no executed oath or declaration has been submitted in the prior application but the names of the inventors were set forth in the application papers pursuant to 37 CFR 1.41(a)(1). Where the names of the inventors are to be added, correction of inventorship can be accomplished by filing a continuing application under 37 CFR 1.53(b) with a newly executed oath or declaration under 37 CFR 1.63(a). Where the name of an inventor(s) is to be deleted, applicant can file a continuing application with a request for deletion of the name of the inventor(s). The continuing application may be filed under 37 CFR 1.53(b) or 37 CFR 1.53(d). Note the requirements of 37 CFR 1.78 (a)(1)(ii)-(iv).

*See also MPEP § 201.03, E. Continuing Applications.*

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<sup>1</sup> This is also applicable to 37 CFR 1.497(d).

10/563,025

In any renewed petition to waive the rules under 37 CFR 1.183, applicants must also explain why this alternative remedy is not appropriate. Additional cost of filing a continuation is not an acceptable response to this question.

**CONCLUSION**

For the reasons discussed above, applicants' petitions under 37 CFR 1.497(d) and 1.183 are both **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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